

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q101075

Shigenori OHKAWA, et al.

Appln. No.: 10/561,483

Group Art Unit: 1626

Confirmation No.: 8172

Examiner: Havlin, Robert H.

Filed: December 20, 2005

For: CANNABINOID RECEPTOR MODULATOR

STATEMENT OF SUBSTANCE OF INTERVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please review and enter the following remarks summarizing the telephonic communications with Examiner Robert Havlin and Quality Assurance Specialist, Bob Wax:

REMARKS

An Examiner's Interview Summary Record (PTO-413) has not yet been provided.

During the interview, the following was discussed:

1. Brief description of exhibits or demonstration: None.
2. Identification of claims discussed: 1
3. Identification of art discussed: Co-pending application No. 11/822,941.
4. Identification of principal proposed amendments: None.
5. Brief Identification of principal arguments: Applicants' representative argued that the provisional obviousness-type double patenting rejection is improper in view of the statutory prohibition under 35 U.S.C. § 121 from using a divisional application, filed as a result of a

restriction requirement, as a reference against the parent application and also because in accordance with the provisions of MPEP 804(I)(B), when a provisional rejection is the only rejection remaining in an application it should be withdrawn.

The Office's initial position was that the divisional application includes overlapping subject matter from the elected Group I of the Restriction Requirement and therefore the rejection is proper. However, Mr. Wax acknowledged that it is common for there to be overlapping subject matter in the claims of pharmaceutical cases especially where there is a genus-species relationship and therefore, it would seem that the statutory prohibition under 35 U.S.C. § 121 against using the divisional application as a reference in this case should apply. Mr. Wax also indicated that there is some confusion and inconsistency in the MPEP on how to handle such a situation and he wanted to check into it further.

6. Indication of other pertinent matters discussed: None.

7. Results of Interview: No agreement was reached.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

It is believed that no petition or fee is required. However, if the USPTO deems otherwise, Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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Date: June 16, 2008